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10/522,809	11/10/2005	Nicholas Russell	034164.002	6771

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SMITH, GAMBRELL & RUSSELL
1130 CONNECTICUT AVENUE, N.W., SUITE 1130
WASHINGTON, DC 20036

EXAMINER
ZAER, ASHRAF A

ART UNIT	PAPER NUMBER
2175	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/522,809	RUSSELL, NICHOLAS
	Examiner	Art Unit	
	ASHRAF ZAHR	2175	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 February 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,9-15,19,31,39-41,43,50,62-64,79 and 80</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,9-15,19,31,39-41,43,50,62-64,79 and 80</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This is second action for application number 10/522,809. Claims *1,9-*

*15,19,31,39-41,43,50,62-64,79 and 8*0 are pending in this application.

Drawings

2.   The applicant's updated drawings have been received and accepted.

Therefore, the examiner is withdrawing his objection to the drawings.

Response to Arguments

3.   Applicant argues, "Slotznick does not teach or suggest any character

server with which the sender and recipient communicate".

        Applicant's argument above is persuasive. Therefore, the rejection has

been withdrawn. However, upon further consideration, a new ground(s) of

rejection is made in view of Slotznick and Kim.

4.   Applicant also argues, "Kim does not teach or suggest a character server

for providing animated characters according to the present invention"

        However, applicant concedes there is some discussion of animation.

Furthermore, col 12, ln 8-22 discuss a server that holds data relating to users,

animation and transmitting this information to all users. Therefore, the examiner

respectfully disagrees with the applicant.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section
> 122(b), by another filed in the United States before the invention by the applicant for patent or
> (2) a patent granted on an application for patent by another filed in the United States before
> the invention by the applicant for patent, except that an international application filed under
> the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
> application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 19, 43, 64, and 80 are rejected under 35 U.S.C. 102(e) as being**

anticipated by Kim, US 6,910,186 (Hereinafter, Kim).

        Regarding Claim 19, Kim discloses "a method for managing an Instant

Messaging (IM) system" (Kim, Fig 4C).

        Kim also discloses "including receiving a request in a character server

from a user for an animated character". Kim discloses of using contracting with

the owner of the image for use of the image (Kim, Fig 4, col 12, ln 9-23).

        Kim also discloses "said request including an identification of a sender of

an IM message to said user". (Kim, Fig 4C, node 132N, col 12, ln 9-23)

        Kim also discloses "querying a database in said character server with said

identification to identify an animated character associated with sender" (Kim, Fig

4C col 12, ln 9-23).

Kim also discloses "receiving said animated character associated with the sender from said database" (Kim, Fig 4B, col 12, ln 9-23).

Kim also discloses "forwarding said animated character from said character server to said user" (Kim, Fig 4B, col 12, ln 9-23).

Regarding Claim 43, this claim is substantially similar to claim 19 and is therefore rejected based upon the same reasoning used to reject claim 19.

Regarding Claim 64, this claim is the apparatus used to perform the method in claim 19. This claim is substantially similar to claim 19 and is therefore rejected based upon the same reasoning used to reject claims 19.

Regarding Claim 80, this claims a program storage device readable by a machine" of the method in claim 19. Therefore, this claim is rejected based upon the same reasoning used to reject claim 19.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 1, 9-10, 13-15, 31, 39-40, 50, 62-63, 79 are rejected under 35**

U.S.C. 103(a) as being unpatentable over Slotznick, US 2001/0033298

(Hereinafter, Slotznick) in view of Kim, US 6,910,186 (Hereinafter, Kim).

Regarding Claim 1, Slotznick discloses "a method for instant messaging
on a computer system". (Slotznick, Fig 1, ¶0032).

Slotznick also discloses "receiving an instant message (IM) containing
content from a sender" (Slotznick, Fig 1, ¶0033).

Slotznick also discloses "displaying said animated character associated
with said sender" (Slotznick, Fig 1, ¶0035).

Slotznick also discloses "delivering said content to a user through said
animated character" (Slotznick, Fig 1, ¶0035).

Slotznick also discloses, "determining an identification of said sender of
said IM from said IM" (Slotznick, Fig 1: 118).

Kim also discloses "sending a request to a character server with said
identification of said sender". Specifically, a server computer is programmed with
chat software to assist in the transfer of information (Kim col 11, ln 65 – col 12, ln
22).

Kim also discloses "receiving from said character server an animated
character associated with said sender". Specifically, a server supplies the
information to all users (Kim, col 12, ln 15-20).

It would obvious to one of ordinary skill in the art at the time of the
invention to combine the instant messaging system in Slotznick with animated

character advertisement in Kim. The motivation for doing so is to increase

interactivity with customer (Kim col 8, In 62-63).

Regarding Claim 9, Slotznick discloses all the limitations of "the method

of claim 1 above".

Slotznick does not disclose "periodically retrieving advertisement details

from a server". Kim remedies this with the disclosure of downloading information

from a server (Kim, col 12, In 9-22). It would obvious to one of ordinary skill in

the art at the time of the invention to combine the instant messaging system in

Slotznick with animated character advertisement in Kim. The motivation for

doing so is to increase interactivity with customer (Kim col 8, In 62-63).

Slotznick also does not disclose "downloading an animated advertising

character specified to represent said advertisement". Kim remedies this with the

disclosure of downloading an organizational avatar (Kim, col 8, In 45-65). It

would obvious to one of ordinary skill in the art at the time of the invention to

combine the instant messaging system in Slotznick with animated character

advertisement in Kim. The motivation for doing so is to increase interactivity with

customer (Kim col 8, In 62-63).

Slotznick also does not disclose "displaying said animated advertising

character specified to represent said advertisement". Kim remedies this with the

disclosure of using the organizational avatar to advertise cost effectively (Kim, col

8, In 45-65). It would obvious to one of ordinary skill in the art at the time of the

invention to combine the instant messaging system in Slotznick with animated

character advertisement in Kim. The motivation for doing so is to increase

interactivity with customer (Kim col 8, ln 62-63).

   Slotznick also does not disclose "delivering content specified for said

advertisement". Kim remedies this with the disclosure of using the organizational

avatar to advertise cost effectively (Kim, col 8, ln 45-65). It would obvious to one

of ordinary skill in the art at the time of the invention to combine the instant

messaging system in Slotznick with animated character advertisement in Kim.

The motivation for doing so is to increase interactivity with customer (Kim col 8,

ln 62-63).

   Regarding Claim 10, Slotznick also discloses "the method of claim 1,

further including: sending an alert to a server" (Slotznick, Fig 1).

   Slotznick also discloses, "receiving a response containing content from

said server generated by an artificial intelligence (AI) application" (Slotznick,

¶0024).

   Slotznick also discloses, "displaying an animated character associated

with said AI application" (Slotznick, Fig 1, ¶0035).

   Slotznick also discloses, "delivering said content to a user through said

animated character associated with said AI application". (Slotznick, Fig 1,

¶0035).

   Regarding Claim 13, Slotznick does not specifically disclose "the method

of claim 1, further including: allowing the sender to select from one or more

predefined animated characters to be displayed on a recipient's computer system
when said user sends an IM message to said recipient". However, Kim remedies
this with the disclosure of having the user enter into a contract with the owner of
an organizational avatar (Kim, col 9, ln 0-19). It would be obvious to one of
ordinary skill in the art at the time of the invention to combine the animated
characters in Slotznick with the ability to select a predefined character in Kim.
The motivation for combining the two references is that the avatar would be used
to represent live persons in shared user environment   (Kim, col 8, ln 48-50).

Regarding Claim 14, Slotznick does not specifically disclose "the method
of claim 1, further including: allowing the sender to upload an image to be used in
creating an animated character to be displayed on a recipient's computer system
when said user sends an IM message to said recipient". However, Kim remedies
this with the disclosure of a generic avatar that could be used to represent a user
(Kim, col 8, ln 52-54). It would be obvious to one of ordinary skill in the art at the
time of the invention to combine the animated characters in Slotznick with the
ability to select an artist created generic avatar in Kim. The motivation for
combining the two references is that the avatar would be used to represent live
persons in shared user environment   (Kim, col 8, ln 48-50).

Regarding Claim 15, Slotznick discloses "a method for instant messaging
on a digital communication system such as a computer system or digital
telephone system or combination thereof, including" (Slotznick, Fig 1, ¶0032).

Slotznick also discloses "receiving one or more instant messages (IM) containing content from one or more senders" (Slotznick, Fig 1, ¶0033).

Slotznick also discloses "delivering said content to a user through said animated character" (Slotznick, Fig 1, ¶0035).

Slotznick also discloses "determining an identification of said sender of said IM from said IM"(Slotznick, Fig 1: 118).

Slotznick does not specifically disclose "forming a queue by creating a dynamic array and inserting incoming message into said queue". Kim remedies this with the disclosure of a buffer to hold data corresponding to related users (Kim, col 12, ln 9-12). It would be obvious to one of ordinary skill in the art at the time of the invention to combine buffer with the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Slotznick does not specifically disclose "controlling the timing of operations of actions in the queue and when required displaying one of said animated characters associated with said sender". Kim remedies this by stating the server supplies information to all users that update their respective displays in the normal manner (Kim, col 12, ln 14-19). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the controlling of timing operations to the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Kim also discloses, "sending a request to a character server with said identification of said sender" Specifically, a server computer is programmed with

chat software to assist in the transfer of information (Kim col 11, ln 65 – col 12, ln 22). It would be obvious to one of ordinary skill in the art at the time of the invention to combine character server with the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Kim also discloses "receiving from said character server an animated character associated with said sender" Specifically, a server supplies the information to all users (Kim, col 12, ln 15-20). It would be obvious to one of ordinary skill in the art at the time of the invention to combine character server with the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Regarding Claim 31, this claim is substantially similar to claim 1 and is therefore rejected based upon the same reasoning used to reject claim 1.

Regarding Claim 39, this claim is substantially similar to claim 9 and is therefore rejected based upon the same reasoning used to reject claim 9.

Regarding Claim 40, this claim is substantially similar to claim 10 and is therefore rejected based upon the same reasoning used to reject claim 10.

Regarding Claim 50, applicant is claiming the apparatus used to perform the method in claim 1. This claim is substantially similar to claim 1 and is therefore rejected based upon the same reasoning used to reject claim 1.

Regarding Claims 62-63, applicant is claiming the apparatus used to perform the method in claims 13-14. These claims are substantially similar to claims 13-14 and are therefore rejected based upon the same reasoning used to reject claims 13-14.

Regarding Claim 79, this claims a program storage device readable by a machine" of the method in claim 1. Therefore, this claim is rejected based upon the same reasoning used to reject claim 1.

9.   **Claims 11-12, 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick, US 2001/0033298 (Hereinafter, Slotznick) in in view of Kim, US 6910186 (Hereinafter, Kim) and in further view of Wolton et al., US 2004/0030741(Hereinafter, Wolton).**

Regarding Claim 11, Slotznick and Kim discloses all the limitations of "the method of claim 10".

However, Slotznick does not disclose "sending a message indicating that a web search is to be performed". Wolton remedies this with a disclosure of a boolean search (Wolton, Fig 4).

However, Slotznick also does not disclose "sending keywords to search in said web search". Wolton remedies this with a disclosure of sending search terms (Wolton, ¶0153).

It would be obvious to one of skill in the art to combine the search engine of Wolton with the messaging system of Slotznick. The motivation to do so is where Wolton states the entire search and retrieval agent system provides a digital character representing individual agents (Wolton, ¶0244).

Regarding Claim 12, Slotznick and Kim also do not disclose "the method of claim 11, wherein said delivering said content comprises delivering results of said web search". Wolton remedies this with a disclosure of a retrieval system (Wolton, ¶244). It would be obvious to one of skill in the art to combine the search engine of Wolton with the messaging system of Slotznick. The motivation to do so is where Wolton states the entire search and retrieval agent system provides a digital character representing individual agents (Wolton, ¶0244).

Regarding Claim 41, this claim is substantially similar to claim 11 and is therefore rejected based upon the same reasoning used to reject claim 11.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHRAF ZAHR whose telephone number is (571)270-1973. The examiner can normally be reached on M-F 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on (571)272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAZ 4/16/08

/William L. Bashore/
William L. Bashore
Primary Examiner
Tech Center 2100